

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) TESSERA 3.0-337 II	
		Application Number 10/786,825 Conf. #5077	Filed February 25, 2004
		First Named Inventor Belgacem Haba and Yoichi Kubota	
		Art Unit 2891	Examiner S.J. Fulk
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>50,916</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p><u>Mitchell J. Mehlman</u> Signature _____ Typed or printed name</p> <p><u>(908) 654-5000</u> Telephone number _____ <u>February 15, 2008</u> Date _____</p>			
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of <u>1</u> form is submitted.</p>			

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: February 15, 2008

Signature:

(Mitchell J. Mehlman)



The present pre-appeal brief request is being filed after the Final Office Action dated January 14, 2008.

Claims 1-32 are pending in this application. Claims 22-32 are withdrawn as being directed to a non-elected invention. In response to Applicants' remarks filed on October 31, 2007, the Examiner issued a Final Action rejecting claims 1-5, 7, 8, 10, 12-18, 20 and 21 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,441,481 to Karpman (hereinafter "*Karpman*"). Claims 6 and 11 are rejected under 35 U.S.C. § 103(a) over *Karpman* and claims 9 and 19 are rejected under U.S.C. § 103(a) over *Karpman* in view of U.S. Patent No. 6,309,910 to Haba et al. (hereinafter "*Haba*"). Applicants respectfully submit that all pending claims are allowable and that the application is in condition for allowance.

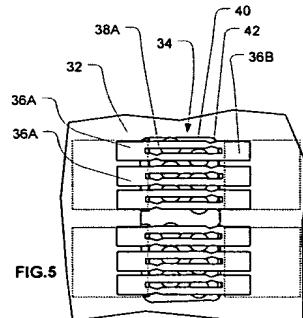
Applicants respectfully submit that the present invention is not anticipated by *Karpman* because *Karpman* does not teach assembling a wafer having a multiplicity of spaced-apart caps projecting upwardly therefrom, with a terminal bearing element incorporating an array of terminals. Specifically, *Karpman* teaches "The cap wafer 20 then is pressed to the frit glass 22 to hermetically seal the microstructures, as shown in FIG. 8." *Karpman*, Col. 5 ll.11-12. Furthermore, *Karpman* teaches ". . . the cap wafer 20 is prefabricated with individual circuits 30 along its surface." *Karpman*, Col. 5 ll.17-18. Clearly, *Karpman* does not teach mounting the terminals simultaneously on a plurality of spaced-apart caps. Rather, in stark contrast, *Karpman* teaches mounting circuitry on a single continuous cap wafer.

As previously argued in Applicants' response filed October 31, 2007, claim 1 recites assembling at least a portion of a wafer having a main surface and a multiplicity of spaced-apart caps projecting upwardly therefrom with a terminal bearing element incorporating an array of terminals. In such

way, the terminals are mounted simultaneously on the plurality of spaced-apart caps.

As used in claim 1, the term "spaced-apart" is given the normal meaning, such that for example, the spaced-apart caps define "depressions in the form of channels between the caps" as disclosed in the present application at paragraph [0032].

An exemplary embodiment is described at paragraph [0036] of the present application: "[b]y assembling the tape to the wafer, terminals and leads are assembled to a large number of caps 14 simultaneously. In the particular embodiment shown [in FIGS. 5 and 6], the terminals [36] are assembled to all of the caps [14] on the entire wafer [10] in a single operation." (See FIG. 5 reproduced below).



As stated above, in Karpman's method, a terminal-bearing element incorporating an array of terminals is not assembled with a wafer having spaced-apart caps so as to mount the terminals simultaneously on the plurality of spaced-apart caps. Rather, Karpman teaches a different method, that is, mounting circuitry on a continuous cap wafer, and then separating the cap wafer into individual capped regions. Applicants assert that Karpman teaches away from Applicants' invention:

"After the cap wafer 20 is sealed to the substrate wafer 10, the next step in the process of the invention is to separate the cap wafer so that unnecessary portions of the cap wafer are removed and access can be gained to the underlying

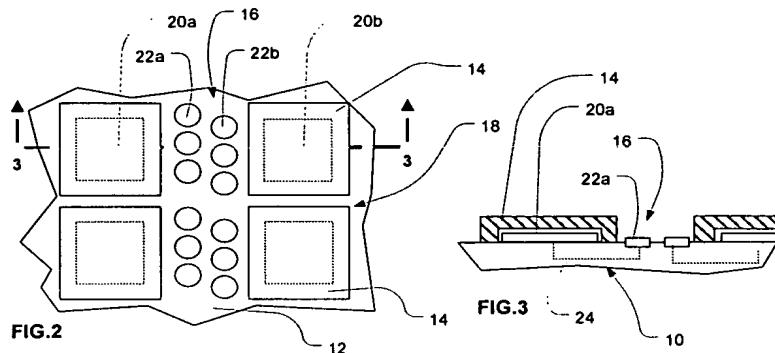
portions of the substrate wafer. FIG. 12 shows this step of the invention." *Karpman*, Col. 5 ll.50-55. [emphasis added]. This cap wafer limitation is also evident by the process flow sequence disclosed in *Karpman* as depicted in figures 6-16 and as described in the associated detailed description. *Karpman*, Col. 5 ll.1 — Col. 6 ll.24.

Additionally, *Karpman* teaches away from the method recited in claim 3, wherein the terminal-bearing element includes leads aligned with channels between the spaced-apart caps. Quite clearly, *Karpman's* method would not work in the process recited in claim 3 because the wafer saw used in *Karpman's* method to cut the wafer would damage the leads of the previously attached terminal bearing element which are aligned with the channels between the caps.

Further, applicants respectfully submit that the invention recited in claim 13 is not taught by *Karpman*. Similar to the discussion above, there are no depressions in the cap wafer described in *Karpman* at the time the terminal bearing element is assembled thereto. Again, *Karpman* teaches that the cap wafer is only cut after attaching circuitry thereto.

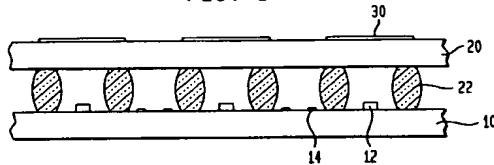
It is respectfully submitted that the Examiner's Response to Arguments in the Office Action dated January 14, 2008, relies on an apparent misconception about the subject matter recited in method claims 1 and 13.

For example, step (a) of claims 1 requires assembling a terminal-bearing element incorporating an array of terminals 22 with a multiplicity of spaced-apart caps 14, so as to mount terminals 22 simultaneously on a plurality of the spaced-apart caps 14 as shown, for example, in FIGS. 2 and 3 below.

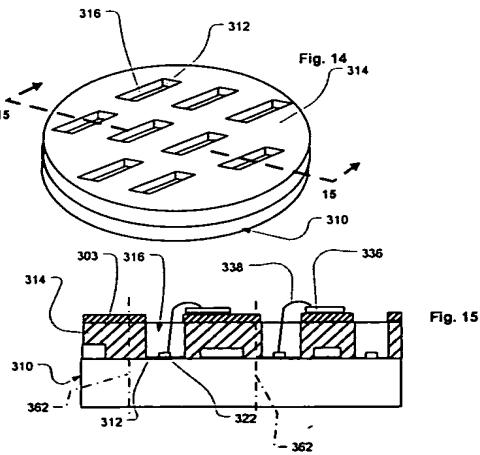


Since Karpman's method does not mount terminals 30 simultaneously to any spaced-apart caps, and only mounts terminals 30 to a single cap wafer 20 (See FIG. 8 below), this element of claim 1 is not met by Karpman.

FIG. 8



Furthermore, claim 13 requires assembling a wafer having depressions extending into the wafer with a terminal-bearing element incorporating an array of terminals so as to mount a plurality of terminals simultaneously on the upper surface of the wafer. Karpman does not teach assembling a wafer 310 having depressions 316 or mounting a plurality of terminals 336 simultaneously on the upper surface 303 of said wafer.



Based on the foregoing, *Karpman* does not anticipate either claim 1 or claim 13 of the present application. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 102 rejection of claims 1 and 13. Applicants also respectfully assert that claims 2-5, 7, 8, 10, and 12 are allowable, at least because they depend from claim 1, and that claims 12-18, 20 and 21 are allowable, at least because they depend from claim 13. Applicants, therefore, respectfully request that the § 102(e) rejection of claims 1-5, 7, 8, 10, 12-18, 20 and 21 be withdrawn.

With respect to the § 103(a) rejection of claims 6 and 11 over *Karpman*, Applicants respectfully assert that claims 6 and 11 are allowable because they depend from claim 1 which, as set forth above, is believed to be allowable. Similarly, Applicants respectfully assert that claims 9 and 19 are allowable because they depend from claims 1 and 13, respectively, which, as set forth above, are believed to be allowable and because the addition of *Haba* does not overcome the deficiencies of *Karpman* with respect to claims 1 or 13. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103 rejection of claims 6, 9, 11 and 19.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance.

845822_1